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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,616	02/07/2006	Horst Mueller	68002-007US1	2023

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EXAMINER	
BUTTNER, DAVID J	
ART UNIT	PAPER NUMBER
1796	

NOTIFICATION DATE	DELIVERY MODE
05/18/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

INFO@ORTPATENT.COM

Office Action Summary	Application No.	Applicant(s)	
	10/567,616	MUELLER, HORST	
	Examiner	Art Unit	
	David Buttner	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 February 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *4* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-3 and 5-20, drawn to phosphonic acid containing microgels, classified in class 525, subclass 158.

II. Claim 4, drawn to phosphonic acid/epoxy adduct containing microgel classified in class 525, subclass 110.

Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product, and the species are patentably distinct (MPEP § 806.05(j)). In the instant case, the intermediate product is deemed to be useful as coating material without having been reacted with epoxy and the inventions are deemed patentably distinct because there is nothing of record to show them to be obvious variants.

Newly submitted claim 4 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 4's adduct does not contain a phosphonic acid as required by all previous claims. The phosphonic group undoubtedly reacts with the epoxy. As the examiner advised in the first office action, a restriction requirement is necessitated.

Since applicant has received an action on the merits for the originally presented invention (requiring phosphonic groups), this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 4 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10's "acrylic or (meth)acrylic acid" is not understood. "(Meth)acrylic acid" itself means acrylic acid or methacrylic acid. What effect does the first "acrylic" have on the phrase "acrylic or (meth)acrylic"?

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 5-20 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chang '532.

Chang exemplifies (first table of col 10) polymerizing methacrylic acid, hydroxyethylacrylate and alkylmethacrylates in the presence of the chain transfer agent DMG COBALT3. Vinylphosphonic aicd (col 5 line 50) can be used in place of DMG

COBALT3. Such a polymerization qualifies as applicant's step a). The resulting macromer is then polymerized with additional monomers (second table of col 10). This qualifies as applicant's additional step recited in claim 2. The resulting material is then reacted with Cymel301 (a melamine resin - second table of col 11) and other additives which qualifies as applicant's step b). The material can be used as a basecoat (col 9 line 15-17) with a large amount of pigment. A binder/pigment ratio of 100/100 would result in a composition having 50% of the solids being the binder.

Applicant's arguments filed 2/18/09 have been fully considered but they are not persuasive.

Applicant argues that Chang does not specifically mention a polyacrylate having hydroxyl, carboxyl and phosphonic acid groups.

This is not convincing. Chang clearly teaches hydroxyl, carboxyl and phosphonic acid groups. In fact, Chang's only example employs a polyacrylate that has both hydroxyl and carboxyl groups. This example only lacks the phosphonic acid group. Chang (col 5 line 39-49) teaches the cobalt chain transfer agent used in the example can be replaced by vinyl phosphonic acid. Such a relacement results in applicant's claimed polyacrylate. Chang lists a dozen or so alternative chain transfer agents. The proposed rejection merely replaces the example's chain transfer agent for another listed by Chang. A reference that clearly names the claimed species is anticipatory no matter how many other species are named (MPEP 2131.02). At a minimum, the reference renders obvious applicant's claims as applicant has merely chosen to claim less than the entire disclosed scope of the reference.

The double patenting/obviousness double patenting rejections over 10-531200 are no longer warranted as that application's allowed claims require a subsequent emulsion polymerization that is prohibited by the instant claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Buttner

5/11/09

/David Buttner/

Primary Examiner, Art Unit 1796